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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213527
Party	Plaintiff Omaha Steaks International, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Omaha Steaks International, Inc.,)	
)	
Opposer,)	Opposition No. 91213527 (Parent)
)	Cancellation No. 92059629
v.)	Cancellation No. 92059455
)	
Greater Omaha Packing Co., Inc.,)	<u>OPPOSER'S TRIAL BRIEF</u>
)	
Applicant.)	

Respectfully submitted,

By: /s/ Nora M. Kane
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III. DESCRIPTION OF THE RECORD

The evidence of record consists of:

1 Opposer's Registrations (status / title)

27 Defendant's Second Notice of Reliance

NR-1 Certificate by Secretary of State of Nebraska certifying that Defendant Greater Omaha was incorporated on July 2, 1956, and is in existence as of February 10, 2016.

NR-2 Certificate by Secretary of State of Nebraska certifying that Defendant Greater Omaha filed Articles of Incorporation on July 2, 1956 and that copies of the Articles of Incorporation and all amendments thereto are attached to the Certificate as of February 10, 2016.

NR-3 Certificate by the PTO Certifying Officer certifying that the attached U.S. Registration No. 4690144 for the GREATER OMAHA trademark is a true copy which is in full force and effect and that title is in Greater Omaha Packing Co., Inc.

NR-4 Certificate by the PTO Certifying Officer certifying that the attached U.S. Registration No. 4721723 for the OMAHA NATURAL ANGUS BY GREATER OMAHA PACKING CO. trademark is a true copy which is in full force and effect and that title is in Greater Omaha Packing Co., Inc.

28 Defendant's Third Notice of Reliance

NR-5 Plaintiff Omaha Steaks' November 12, 2014 Responses to Defendant Greater Omaha's September 22, 2014 Request for Admission.

29 Defendant's First Notice of Reliance

118 registrations and applications, both live and dead, each of which contains a disclaimer of the geographically descriptive name of the city OMAHA and 118 copies of

the listed registrations and applications, which copies have been printed from PTO's electronic database records.

30 Defendant's Fourth Notice of Reliance

NR-9 Polk City Directories Website printout dated April 4, 2015.

NR-10 Polk Omaha City Directory dated 1928.

NR-11 Polk's Omaha City Directory dated 1929.

NR-12 Polk's Omaha City Directory dated 1931.

NR-13 Polk's Omaha City Directory dated 1932.

NR-14 Polk's Omaha City Directory dated 1933.

NR-15 Polk's Omaha City Directory dated 1934.

NR-16 Polk's Omaha City Directory dated 1936.

NR-17 Polk's Omaha City Directory dated 1938.

NR-18 Polk's Omaha City Directory dated 1940.

NR-19 Polk's Omaha City Directory dated 1942.

NR-20 Polk's Omaha City Directory dated 1945.

NR-21 Polk's Omaha City Directory dated 1946.

NR-22 Polk's Omaha City Directory dated 1949.

NR-23 Polk's Omaha City Directory dated 1951.

NR-24 Polk's Omaha City Directory dated 1954.

NR-25 Polk's Omaha City Directory dated 1955.

NR-26 Omaha World Herald Wikipedia website printout dated February 19, 2016.

NR-27 Omaha World Herald Historical Archive dated January 11, 1927.

NR-28 Omaha World Herald Historical Archive dated September 24, 1944.

NR-29 Omaha World Herald Historical Archive dated October 14, 1945.

NR-30 Omaha World Herald Historical Archive dated July 28, 1947.

NR-31 Omaha World Herald Historical Archive dated July 20, 1951.

NR-32 Omaha World Herald Historical Archive dated September 29, 1952.

NR-33 Omaha World Herald Historical Archive dated February 12, 1953.

NR-34 Omaha World Herald Historical Archive dated May 31, 1953.

NR-35 Omaha World Herald Historical Archive dated July 19, 1953.

NR-36 Omaha World Herald Historical Archive dated December 25, 1955.

NR-37 Omaha World Herald Historical Archive dated January 30, 1958.

NR-38 Omaha World Herald Historical Archive dated May 17, 1960.

NR-39 Omaha World Herald Historical Archive dated June 18, 1960.

NR-40 Omaha World Herald Historical Archive dated October 24, 1972.

31 Defendant's Fifth Notice of Reliance

NR-41 Obituary of Herman Cohen published in Omaha World Herald Newspaper on November 7, 1978.

NR-42 Obituary of Pennie Z. Davis published in Omaha World Herald Newspaper on April 1, 2002.

NR-43 "A Gem of the Midwest" article published in Hartford Courant newspaper on July 18, 2004 stating that Omaha is known for its beef.

NR-44 Husker BBQ website article entitled "Omaha Beef" – printout dated October 2, 2014.

NR-45 Omaha Travel Guide website article stating that Omaha is known for high quality corn-fed beef – printout dated October 3, 2014.

NR-46 Trip Advisor website article entitled "This Place is Why It's Called Omaha Beef"- printout dated October 2, 2014.

NR-47 Great American Farms, Inc. website showing that seller of beef and meat products states that "When you think of GOURMET STEAKS from OMAHA, then use your imagination and think about a steak so tender, so juicy, and so lean that you will know you are in heaven" – printout dated September 11, 2014.

NR-48 Food & Spirits Magazine website showing that publisher of food articles states that "Omaha is known for its beef." – printout occurred in 2014.

NR-49 Omaha Prime website showing that Omaha Prime Restaurant is located in Omaha – printout dated October 2, 2014.

NR-50 B.I.G. Meats Omaha website showing that seller of beef and meat products is located in Omaha – printout dated June 29, 2015.

NR-51 Omaha Meat Processors – website pages showing that seller of beef and meat products is located in Omaha – printouts dated September 21, 2016.

NR-52 Omaha Picnic Pros website showing that seller of beef and meat products is located in Omaha- printout dated September 11, 2014.

NR-53 Vic's Omaha Popcorn showing that seller of popcorn is located in Omaha – printout dated September 11, 2014.

NR-54 Omaha Beer Fest website showing that seller of beer and beef and other food products is located in Omaha – printout dated October 3, 2014.

NR-55 Omaha Restaurant Association website showing that restaurant association, which includes many steakhouses as members, is located in Omaha – printout dated March 12, 2015.

NR-56 Omaha Restaurant Week website showing that marketer of steakhouses and other restaurants is located in Omaha - printout dated March 12, 2015.

NR-57 Omaha Culinary Tours website showing that seller of Omaha steakhouse tours is located in Omaha – printout dated October 2, 2014.

NR-58 Cargill website showing that it sells MORTON'S OF OMAHA-branded roast beef – printout dated September 11, 2014.

NR-59 Omaha Beef Company website showing that seller of beef and meat products has been in business since 1881 – printout dated February 22, 2016.

NR-60 Del Monte Eat Co. Inc. website showing that seller of Greater Omaha – branded beef products is located in Omaha – printout dated June 29, 2015.

NR-61 Defendant Greater Omaha's website showing historical and other articles – printout dated January 19 and 20, 2015.

NR-62 Business Ethics Alliance article describing interview with Henry Davis, President of Defendant Greater Omaha about the history of Greater Omaha – printout shows copyright date of 2011.

33 Testimony Deposition of Bruce Simon taken January 13, 2016 and Testimony Deposition of Todd Simon taken January 12, 2016

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Exhibit 11 5/16/12 Cease and Desist Letter

Exhibit 12 11/3/09 Cease and Desist Letter

Exhibit 13 10/17/12 Cease and Desist Letter

Exhibit 14 1/22/14 Cease and Desist Letter

Exhibit 15	7/29/13 Cease and Desist Letter
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Exhibit GOP-8	3-25-92 USDA Application
Exhibit GOP-9	Time Change Announcement
Exhibit GOP-10	1997 Greater Omaha Brochure
Exhibit GOP-11	March 3-9, 1997 Midlands Business Journal
Exhibit GOP-12	1-23-98 Drawing of Greater Omaha Logo Shipping Box
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40 Testimony Deposition of Terri Peetz taken March 18, 2016

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Exhibit 30	Supplemental Expert Report of Hal Poret dated August 2015
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IV. STATEMENT OF THE ISSUES

Should Greater Omaha Packing Company's trademark applications and registration be prohibited and cancelled, respectively, because they so resemble Omaha Steaks' trademarks previously registered as to be likely to present a likelihood of confusion?

Yes. An analysis of these trademarks through the lens of the *du Pont* Factors mandates this result.

V. FACTUAL BACKGROUND

Omaha Steaks International, Inc. (“Omaha Steaks”) has grown from its humble 1917 beginnings to a nationwide presence. Todd Simon Dep. 4:2-19. Omaha Steaks manufactures, markets and distributes a wide variety of premium steaks, red meats and other gourmet foods. These retail products are custom cut and packaged to serve the needs of its individual customers in various markets. Headquartered in Omaha, Nebraska, with 1,800 employees, its nationwide markets include foodservice, mail order, incentive, telesales, its own retail stores, licensed restaurants, sales to specialty and food stores, and online sales. The trademark, Omaha Steaks, has been promoted and advertised for decades, with an advertising budget in excess of \$50,000,000. Omaha Steaks has registered over 25 trademarks prominently using the words “Omaha Steaks,” including “Omaha Fresh Angus by Omaha Steaks,” and “Omaha Steaks Angus,” and has advertised its goods and services under “Omaha Steaks” since as early as 1958. Todd Simon Dep. at 99:1-102:13.

Greater Omaha Packing Co., Inc. also has a history in Omaha, Nebraska, albeit in a historically different marketplace. Greater Omaha Packing has long been in the business of slaughtering cattle and providing large sections of the carcasses, “boxed beef,” for further processing into individual cuts for end-users by retail companies such as Omaha Steaks.

This consolidated proceeding was initiated to oppose Greater Omaha Packing’s registration of the trademark “GREATER OMAHA PROVIDING THE HIGHEST QUALITY BEEF and design (the “GREATER OMAHA BEEF Mark”):



GREATER OMAHA

PROVIDING THE HIGHEST QUALITY BEEF

Application No. 85897951. The goods claimed under this mark are “meat, including boxed beef cuts.”

This consolidated proceeding was also initiated to cancel Greater Omaha Packing’s registration of the trademark “U.S. BEEF 1881 OMAHA HEREFORD CORN FED:”



Registration No. 3998763. The goods claimed under this mark are “Hereford Beef.”

This consolidated proceeding was also initiated to cancel Greater Omaha Packing’s registration of the trademark: “OMAHA NATURAL ANGUS CORN FED MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS:”



Registration No. 4006768. The goods claimed under this mark include: “Angus Beef.”

The Omaha Steaks trademarks relied upon in this consolidated proceeding are attached as Exhibit B to the Notice of Opposition and include the following Registration Nos. and claimed goods (in relevant part): Opposer's Registration Nos. 1458802, 1515602 (meat sold to hotels, restaurants and institutions), 1555215, 1674686, 2002499 (fresh and frozen boxed steaks, and fresh and frozen cuts of meat), 2840193 (meat...hamburger patties, corned beef...roast beef), 2893159, 3758608, 3768689 (frozen entrees consisting primarily of meat...frozen meals consisting primarily of meat...meat), 3768690, 3768693, 3857500, 4172329, and 4172330 are incontestable pursuant to 15 U.S.C. §1065, which provides conclusive evidence of Opposer's ownership of the marks therein, of the validity of the marks therein, and of Opposer's exclusive right to use the marks in commerce in connection with the goods and/or services identified in the registrations pursuant to 15 U.S.C. §1115(b).

Opposer's Registration Nos. 1005036, 1005037, 1007997, 1458802, 1515602, 1555215, 1674686, 2002499, 2414603, 2840193, 2893159, 3768689, 3768691 (frozen entrees consisting primarily of meat), 3768693 (frozen entrees consisting primarily of meat), 3774260 (frozen entrees consisting primarily of meat), 3799411, 3857498 (on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items; retail store services featuring food and food-related items), 4172329 (Angus meat), and 4172330 (meat) are 2(f)

registrations based on acquired distinctiveness of the words OMAHA, OMAHA STEAKS or OMAHA STEAKS ANGUS.

VI. ARGUMENT

A. Likelihood of Confusion Standard

Section 2(d) of the Lanham Act prohibits registration of a mark that consists of or is comprised of a mark that “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the application, to cause confusion, or to cause mistake, or to deceive . . .” 15 U.S.C. § 1052(d). Whether a likelihood of confusion exists is a question of law, determined on a case-by case basis, applying the relevant *du Pont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

B. Application of the du Pont factors

1. Factors 1 and 2: The Two Key Considerations of the Likelihood of Confusion Analysis

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.” *Edom Labs., Inc. v. Lichter*, 102 U.S.P.Q.2d 546, 549 (TTAB 2012). Specifically, “the degree of similarity necessary to support a conclusion of likely confusion declines” if the parties’ goods are virtually identical. *In re Dixie Restaurants*, 105 F.3d 1405, 1408 (Fed. Cir. 1997) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992)).¹

a. The Marks Are Similar In Appearance, Sound, Connotation & Commercial Impression

¹ See also *In re Viterro Inc.*, 671 F.3d 1358, 1368 (Fed. Cir. 2012) (noting that when the goods at issue are identical, the degree of similarity between marks necessary to establish likelihood of confusion declines); *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011) (“When trademarks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”); *Edom Labs., Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1551 (TTAB 2012) (noting that degree of similarity necessary to support likely confusion declines when the marks appear on identical goods).

An examination of the marks demonstrates that they are so similar in appearance, with an identical “Omaha” and the prominence thereof in all of the marks, sound and overall commercial impression that they are likely to be confused with one another based solely on the similarities in any one of these categories. *See Krim-Ko Corp. v. The Coca-Cola Bottling Co. of N.Y.*, 390 F.2d 728, 731-33 (C.C.P.A. 1968) (recognizing that similarity in any one of these three categories may be sufficient to support a conclusion that confusion is likely).

b. The Parties’ Description of Goods are Nearly Identical

Greater Omaha Packing has or seeks registration of its marks for these products: “meat, including boxed beef cuts,” “Angus Beef,” “Hereford Beef.” These are identical, or nearly so, to products upon which Omaha Steaks owns registrations.

These similarities and likenesses accentuate the likelihood of consumer confusion about the sources of goods marketed under similar marks. *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 877 (Fed. Cir.), *cert. denied*, 113 S. Ct. 812 (1992).

The issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods identified therein. The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Systems, Inc. v. Houston Computers Services, Inc. 918 F.2d 937, 942 (Fed. Cir. 1990) (numerous citations omitted).

A likelihood of confusion as to any one of the products claimed in Applicant’s applications is “sufficient to support a conclusion that the opposition should be sustained.” *Edom Labs.*, 102 U.S.P.Q.2d at 1550. In view of the identical nature and obvious overlap in the goods claimed in Greater Omaha’s applications / registrations with Omaha Steaks’ prior

registrations, this consideration unequivocally and heavily weighs in favor of a finding of likelihood of confusion.

2. *Factor Number 3: The Parties Goods Are Or Will Be Marketed And Sold In The Same Trade Channels And To The Same Classes of Purchasers*

The third factor calls for consideration of “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *du Pont*, 476 F.2d at 1361. The facts here make it plain that Applicant’s goods identified in its registrations and Omaha Steaks’ goods are so similar that the marks would be encountered by a person under circumstances which would likely give rise to confusion. Thus, the third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

As noted above, Omaha Steaks serves nationwide markets, including foodservice, mail order, incentive, telesales, its own retail stores, licensed restaurants, sales to specialty and food stores, and online retail sales. Its products are intended for the end-user, individual buyer to prepare and eat.

Greater Omaha Packing, on the other hand, has long been in the business of slaughtering cattle and providing large sections of the carcasses, “boxed beef,” for further processing into individual cuts for end-users by companies such as Omaha Steaks. However, its applications and registrations contain no such restrictions, diminishing the import of these historical means of doing business.

It is well-settled that evidence of current channels of trade may be irrelevant to the analysis in light of the competing registrations:

the fact that they are presently only sold to industrial concerns is of no particular consequence here, since it merely involves a trade practice of applicant which is subject to change at any time. But more than that, since the identifications of goods in applicant's application and opposer's registrations comprehend identical products, and neither contains any limitations as to the manner in which the goods are to be marketed or to the class of purchasers to whom they are to be sold, no material distinction can be drawn between them for the purposes of registration.

Crown Industrial Prod. Co. v. Crown Central Petro. Corp, 440 F.2d 446, 447-48 (C.C.P.A. 1971) (quoting with approval the Board's decision to deny registration) (citations omitted).

3. *Factor Number 4: The conditions under which and buyers to whom sales are made*

This factor is neutral as to the parties' historic buyers. Greater Omaha Packing is free to enter into the retail market. However, while it is certainly entitled to expand its business in whatever way it chooses, Greater Omaha Packing cannot be allowed to use identical trademarks on identical goods in targeting the identical retail market.

4. *Factor Number 5: The Fame of the Mark OMAHA STEAKS*

The fame of the mark "Omaha Steaks" is indisputable, as evidenced by, *inter alia*, its length of use, nationwide extent of advertising, and its sales. Omaha Steaks and its predecessor companies have been in business for nearly 100 years. 28 TTAB, Def. Third Notice of Reliance at GOP 1043. In 1966, Opposer changed its corporate name to Omaha Steaks International, Inc. *Id.* at 1042. Omaha Steaks has advertised its goods and services under the "Omaha Steaks" mark since as early as 1958. 33 TTAB, Todd Simon Dep. at 99:1-102:13.

Omaha Steaks' domestic advertising budget during the years 2011, 2012, and 2013 ranged from \$45,000,000 to \$50,000,000+. *Id.* at 15:18-17:3. Its products are promoted through catalogs, direct mailings, e-mail marketing, tradeshow, 75 retail stores, national television, radio, magazine and newspaper campaigns, digital marketing, and social media, among others. *Id.* at 18:4-27:23. The retail stores are located in approximately 26 states, including New York, Illinois, Florida, Georgia, Ohio, Kentucky, Missouri, Nebraska, California, Colorado, Nevada, Pennsylvania, New Jersey and Texas. *Id.* at 48:9-25.

Todd Simon is Vice President of Omaha Steaks and has personally appeared on the following television shows and networks to promote the company's goods and services under the

Omaha Steaks mark: “Fox & Friends,” “The View,” “Celebrity Apprentice,” “Hell’s Kitchen,” CNBC, CNN, and MSNBC. *Id.* at 27:24-29:4. Omaha Steaks has been featured on “The Oprah Winfrey Show” (*id.* at 29:13-21), “The Ellen DeGeneres Show” (*id.* at 29:25-30:3), “Food Factory” (*id.* at 30:8-13), “Unwrapped” (*id.* at 30:13-15), and “Military Makeover” (*id.* at 33:19-34:22). Wikipedia reports that Omaha Steaks has also been featured on "Good Morning America," "CBS Early Show," "Rules of Engagement," "The Dr. Phil Show," "The Rachel Ray Show," "The Larry Sanders Show," "Modern Family," "Live With Regis and Kelly," "Tosh.0," "The Simpsons," and "Fear the Walking Dead." https://en.wikipedia.org/wiki/Omaha_Steaks (last visited July 18, 2016).

Omaha Steaks’ goods and services are promoted under the Omaha Steaks mark throughout Omaha’s largest public venues, including the CenturyLink Center arena, TD Ameritrade Park (site of the College World Series of Baseball every June), Ralston Arena, Storm Chasers Stadium, and the Omaha Henry Doorly Zoo. Todd Simon Dep. at 46:8. Omaha Steaks has two kiosks in the Omaha airport, where travelers can purchase steaks to take with them or place an order for steaks to be shipped. *Id.* at 47:5-22. The kiosks have appeared in nationally-released films “Up in the Air” and “About Schmidt.” *Id.* at 53:7-9.

Omaha Steaks has been mentioned in other films, including “Dodgeball” (*id.* at 9:19-21), “Flipper” (*id.* at 53:22-54:54), and in national television shows, including “The West Wing” (*id.* at 54:9-55:1), “Seinfeld” (*id.* at 55:1-55:8), “The George Lopez Show” (*id.* at 55:10-16), and “Dennis Miller Live” (*id.* at 55:17-56:10).

Omaha Steaks has also been featured in Time, Newsweek, Playboy, and PC Magazine. Todd Simon Depo. 79:9-80:5. Reports of other media hits are exemplified at Todd Simon Deposition Exhibit 8 (34 TTABVUE), which is only a sampling a comprehensive media listing

of all the news items containing references to Omaha Steaks during recent years. Todd Simon Depo. 80:19-94:23.

In light of the foregoing, it is fair to say that Omaha Steaks enjoys widespread national and cultural fame. *Cf. BVD Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 728 (Fed. Cir. 1988) (taking judicial notice of facts of universal notoriety in concluding that "B.V.D." was at least widely, if not universally known).

As discussed more fully below, Omaha Steaks adduced rebuttal testimony from its survey expert, who opined that both the term "Omaha Steaks" and the term "Omaha" on its own have achieved secondary meaning in the category of meat products that are marketed through the channels that Omaha Steaks use. 44 TTABVue, Poret Dep. at 14:11-18.

(5) The number and nature of similar marks in use on similar goods.

This factor requires consideration of "[t]he number and nature of similar marks in use on similar goods. Greater Omaha Packing did not adduce any probative evidence on this factor. Instead Greater Omaha Packing presented Ms. Terri Peetz, a paralegal employed by one of its law firms to present evidence that she visited various establishments with whom she did business and which use the word "Omaha" in their business name. *See generally* TTAB 40, Peetz deposition, filed by Greater Omaha Packing on April 19, 2016. Omaha Steaks objected to this testimony as it constituted improper *ex parte* discovery from non-party witnesses (Greater Omaha Packing did not give notice of Ms. Peetz' activities), hearsay, and violation of the witness-advocate rule. *Id.* at 3:10-5:24. Those objections are hereby incorporated and renewed herein. None of the businesses that Ms. Peetz visited or with whom she communicated are in the business of providing individual, uncooked beef products or otherwise compete with Omaha Steaks. For example, she visited:

- “Omaha Tower Café,” a “quaint café located in the lobby of a very large office building” where she had lunch. *Id.* at 14:4-18.
- “Omaha Oriental Food & Gifts,” a “specialty store selling oriental foods, grocery goods, and gifts” *id.* at 15:12-16:18, where she purchased three items, including gum, for \$6.90. *Id.* at 36:325.
- “Omaha Popcorn,” a store located in a strip mall selling various flavors of popcorn, drinks and popcorn containers,” where she purchased flavored popcorn. *Id.* at 17:21-18:11.
- “Omaha Tap House,” “a casual restaurant located in downtown Omaha,” where she had dinner. *Id.* at 19:11-20:6.
- “Omaha Wine Company,” “a specialty store selling various wines, alcoholic beverages,” where she purchased a bottle of wine and a bottle of vodka. *Id.* at 21:2-21:13.
- “OmahaFastFoods.com,” a “grocery delivery service for the Omaha metro area”, from which she purchased several items, but no beef or meat products. *Id.* at 22:14-23:8; 38:8-22.
- “Omaha Prime,” an “elegant steakhouse” in Omaha, where she had a steak dinner. *Id.* at 24:5-24:14.
- “Omaha Picnic Pros,” a “catering service specializing in barbecuing and grilling located in southern Omaha,” where she purchased nothing. *Id.* at 25:17-26:8.
- “Omaha Culinary Tours,” a “[b]us tour featuring some of Omaha’s most well-known steakhouses,” a tour in which she participated. *Id.* at 27:3-14.

In a further effort to introduce third party uses of similar marks, Greater Omaha Packing filed its Fifth Notice of Reliance (31 TTABVUE), which purports to rely upon websites showing sellers of beef, beef-related goods or services, or popcorn using the word “Omaha.”

This “evidence” of third party uses of dissimilar marks on dissimilar goods has no relevance. *See World Triathlon Corp. v. Traditional Medicinals, Inc.* Opp. No. 91110391 at *7 (TTAB Nov. 3, 2008) (rejecting alleged evidence of “widespread third-party use” because “most of these third-party registrations are for goods and services that are far removed from the goods at issue herein”); *Century 21 Real Estate*, 970 F.2d at 877-78 (weighing the “paucity” of evidence of third party marks for similar services, and applying the familiar doctrine, “any doubts about likelihood of confusion . . . must be resolved against the newcomer.”) (citations omitted); *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.* 937 F.2d 1572, 1579 (Fed. Cir. 1991) (alleged evidence of third party use outside of the relevant field “is not only unpersuasive but essentially meaningless.”).

There is simply no acceptable evidence presented by Greater Omaha Packing that any person or entity is using or has used a similar mark for similar goods and services, or any of the necessary accompanying information. Third party uses are not entitled to any weight without probative evidence demonstrating the nature and extent of use, actual sales, whether or to what extent consumers are aware of them, and so on. *See AMF, Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406 (C.C.P.A. 1973).

In rebuttal to Greater Omaha Packing's attempt to gain traction under the sixth factor, Omaha Steaks adduced evidence from its survey expert, who testified that his opinion that Omaha Steaks had acquired secondary meaning would not be impacted by the existence of other, unrelated businesses using “Omaha” in their names. 44 TTABVUE, Poret Dep. at 24:16-25:10.

In sum, the sixth factor weighs in favor of a finding of likelihood of confusion.

- (6) The nature and extent of any actual confusion.

There is no dispute that the record lacks any evidence of actual confusion. This fact does not preclude a conclusion that there is a “likelihood” of confusion. *Bandag, Inc. v. Al Bolser’s Tire Stores*, 750 F.2d 903, 914 (Fed. Cir. 1984) (noting that “because actual confusion is difficult to produce and frequently discounted as unclear or insubstantial . . . this factor is weighed heavily only when there is evidence of past confusion[.]”) (citations & internal quotations omitted).

- (7) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

There is no evidence to suggest that there has been concurrent use in the retail market.

- (8) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).

“Omaha Steaks” appears on every single package sold by Omaha Steaks. Todd Simon Dep. at 128:16-21.

- (9) The market interface between applicant and the owner of a prior mark

Omaha Steaks has purchased boxed beef from Greater Omaha Packing for decades, and continues to do so. 28 TTABVue, Omaha Steaks Responses to Requests for Admissions, 1043 at ¶8.

- (10) The extent to which applicant has a right to exclude others from use of its mark on its goods.

Omaha Steaks has a successful history of protecting its trademarks by registering them with the PTO. It also diligently polices its trademarks, sending cease and desist letters, and

pursuing litigation if necessary. *See* Bruce Simon Dep. 13:11-25:24 & his deposition exhibits 10-25 (identifying Deposition Exhibits 10-25 as cease and desist letters sent on behalf of Omaha Steaks). Omaha Steaks has filed numerous lawsuits against perceived infringers, of which this Court must take judicial notice under Federal Rule of Evidence 201(c)(2); 37 CFR § 2.122: *Omaha Steaks International, Inc. v. Interbay Food Company, LLC*, 8:14-cv-15 (D. Neb.) (suing for trademark infringement for, inter alia, Defendant's advertising of its product on its own website and at Amazon Fresh as "Omaha Natural Angus" and "Greater Omaha."); *Omaha Steaks International, Inc. v. Pathak*, 03-cv-01401 (C.D. Cal.); *Omaha Steaks International, Inc. v. Midwest Best Choice Distributors, LLC*, 13-4095 (N.D. Iowa); *Omaha Steaks International, Inc. v. Fairbury Steaks, Inc.*, 07-cv-02578 (C.D. Cal.); *Omaha Steaks International, Inc. v. Turner New Zealand, Inc.*, 05-cv-00605 (S.D. Cal.); *Omaha Steaks International, Inc. v. Kansas City Steak Co., LLC*, 07-cv-01061 (C.D. Cal.); *Omaha Steaks International, Inc. v. O'Reilly*, 98-cv-00306 (N.D. Tex.); *Omaha Steaks International, Inc. v. Parrish*, 03-cv-04884 (S.D. Texas); *Omaha Steaks International, Inc. v. What's Your Beef Incorporated*, 00-cv-02021 (D. Ariz.); *Omaha Steaks International, Inc. v. Perera d/b/a Omaha Steaks of AZ*, 96-cv-00419 (D. Ariz.); *Omaha Steaks International, Inc. v. Raemica, Inc.*, 08-cv-06975 (C.D. Cal.); *Omaha Steaks International, Inc. v. U.S. Beef, Inc.*, 98-cv-00536 (N.D. Cal.); *Omaha Steaks International, Inc. v. Omaha's Choice Quality Steak and Poultry*, 97-cv-02103 (D. Minn.); *Omaha Steaks International, Inc. v. Huisken Meat Company of Sauk Rapids, Inc.*, 04-cv-00205 (D. Neb.); *Omaha Steaks International, Inc. v. Minnesota Meat Distributors*, 97-cv-00408 (D. Neb.); *Omaha Steaks International, Inc. v. Simpson*, 99-cv-00712 (S.D. W. Va.).

(12) The extent of potential confusion, *i.e.*, whether *de minimis* or substantial.

The extent of possible confusion is undeniably substantial. It is telling that Greater Omaha Packing chose the December holiday season to enter the retail market, targeting individual consumers. Bruce Simon testified that Omaha Steaks increases its workforce during that season by 3,500 employees (from 1,800 to 4,300) because they are processing approximately 100,000 orders per day. Bruce Simon Dep. at 7:13-25. At an average of \$110.00 per sale,² that constitutes approximately \$11 million dollars in daily sales.

Among other protections, trademarks protect investments of property owners and ensure proper return to those who invested work and capital into their trademarks, their indisputable "property right[s]". *Kenner Park Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 354 (Fed. Cir.), *cert. denied*, 113 S.Ct. 181 (1992) (citations & internal quotations omitted). "A competitor can quickly calculate the economic advantages of selling a similar product in an established market without advertising costs." *Id.* at 353.

² Todd Simon Dep. at 132:19-23.

VII. SUMMARY

The doctrine that any doubt about confusing similarity should be resolved against the newcomer is paramount in Lanham Act cases. *Kenner*, 963 F.2d at 355. Here, the *du Pont* Factors weigh in favor of a likelihood of confusion. Omaha Steaks constitutes a strong mark, casting a “long shadow” which its competitors must avoid. *Id.* at 353. Omaha Steaks respectfully requests that the Board prohibit registration and cancel the respective challenged marks.

DATED this 19th day of July, 2016.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was served on Applicant by sending the same this 19th day of July, 2016, via electronic mail to I. Stephen Samuels at ISS@SamuelsTM.com.

/s/ Nora M. Kane
Nora M. Kane, Attorney for Opposer